

REMARKS

Claims 1-7, 13, 16-17, and 18-20 stand rejected under 35 USC 102(e) over Ensel et al., U.S. Patent No. 6,493, 685.

Claims 1-9, 11-23 and 26-27 stand rejected under 35 U.S.C. §101 on the grounds that “the claimed invention is directed to non-statutory subject matter.” Applicant believes the Examiner is wrong on this point, and that the Examiner does not possess a sufficient understanding of the current standard. First the Examiner reminds Applicant that the patent laws flow from the U.S. Constitution. Then the Examiner sets forth a test articulated in 1970 regarding whether or not the invention “is within the technological arts.” The Examiner mentions a few exceptions to statutorily acceptable subject matter, including “laws of nature,” “natural phenomena,” and “abstract ideas.” The Examiner makes reference to a “two prong” test, but never really states what the prongs are. Nevertheless, he cites *In re Toma* as being within the “technological art” because the claimed invention was an operation being performed by a computer within a computer.

The Examiner discusses *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, arguing that this case “never addressed the [technological art] prong of the test.” The Examiner seems to be saying that Applicant’s claims are non-statutory “because of the presence of an abstract idea,” but never really advances this argument. Rather, the Examiner ultimately relies on the case of *Ex Parte Bowman* for a finding that “the claimed invention is non-statutory.” The Examiner concludes by stating that “None of the steps necessarily indicate any connection to a computer or technology,” and certain steps “could be performed manually by people.”

However, Applicant believes the Examiner’s arguments are misdirected on several grounds. First, simply because *some of the steps* may be performed by human beings is irrelevant, so long as other steps necessarily involve a computing machine. In claim 1, for example, Applicant would like the Examiner to explain how a human being could “extract a list of software objects,” or “invoke at least one of the software objects to collect data.” Additionally, the instant invention claimed as filed clearly distinguishes over the *Bowman* case. In *Bowman*, the decision to call the claimed subject matter non-statutory was based in large measure on the fact that nowhere in the claims *or the specification* did appellant make reference to tangible hardware. Such is not the case with the instant invention. The

Examiner's attention is directed, for example, to page 5 of the specification, lines 6-9, which state that "It is contemplated that the methods of production include computer-generation, printing operations, internet web page generation, and the like. Various embodiments of bills include computer-generated displays (remote and local), printed material, and the like." Moreover, claim 1 has been amended to include the recitation that the various steps are performed "in a local, expanded or global computing environment," which finds support on page 7 of the specification at lines 3-4. As per independent claim 18, it is noted that this is a system claim and not a method, such that the various elements constitute things and not mere processes. For all of these reasons, Applicant argues that the invention is directed to statutory subject matter under 35 U.S.C. §101.

Claims 1-7, 13, 16-17 and 18-20 stand rejected under 35 U.S.C. §102(e) over Ensel et al. ('685). Applicant contends that the Examiner's interpretation of the Ensel reference is incorrect. Broadly, Ensel does not describe any mechanism for the creation of bill content whereas the instant application is focused on the creation of bill content. Ensel is primarily an invention for mediating the billing, payment, and customer care services for one or more billers to many customers.

Reference is made to column 6, line 39 of Ensel, wherein it is described how a bill format is defined by an external source "biller." Applicant's claims, however, are directed to the creation of bill content. At Column 6 line 40 the Ensel patent states that there is no restriction on bill format. This is because it has no involvement in the creation of bill content.

More particularly, whereas the claims of Applicant focus on the creation and ordering of bill content, the Ensel patent resides in "formatting" for a media of display (See column 6, lines 56-67 and column 7, lines 1-5). Column 6, line 44-50 discusses reformatting and formatting for the proper channel. In this context, the word "format" refers to formatting content for different media. For example, the bill content may be "formatted" into HTML or XML for web presentation. Alternatively, it may be formatted in PDF for download and printing. Yet another format for email distribution is noted.

Such passages in Ensel refer to the conditional insertion of a marketing insert, for example, through the use of a query to review the current bills of all the customers. Although this loosely resembles Applicant's software objects used to query data sources to calculate bill totals or subtotals, the Ensel invention refers to the insert as an existing document that is "sorted into" the bill content

based on the results of a query. This clearly teaches away from the actual generation of a particularized bill content.

Overall, the Ensel invention is focused on the mediation between billers and billed parties. It also is focused on the insulation of the biller from the complexities of multiple channels of distribution and payment. The instant invention, in contrast, claims various mechanisms to provide flexibility and customization for the creation of bill content.

At column 8, lines 18-21, Ensel refers to the ability to take "raw billing data" and format it for customer presentation. It makes no reference to any procedure, process or mechanism to create the formatted data. At column 9, lines 12-17, Ensel repeats its assertion of the ability to format billing data without any description of mechanism.

With respect to Applicant's claimed use of "objects," Ensel at column 10, lines 65 refers to E-bill files being stored as objects in an object oriented file. It refers to receiving these objects from an external source. It doesn't refer to the creation of the objects.

Based upon the foregoing amendments and comments, Applicant believes all pending claims are in condition for allowance. Questions regarding this application may be directed to the undersigned attorney at the telephone/facsimile numbers provided.

Respectfully submitted,

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